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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,550	03/10/2004	Blayn W. Beenau	60655.5500	2549
5514	7590	09/07/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			VY, HUNG T	
			ART UNIT	PAPER NUMBER
			2163	

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/708,550

Applicant(s)

BEENAU ET AL.

Examiner

Hung T. Vy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on the preliminary amendment filed on 12/14/04
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ( <u>see office action</u> ) | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Summary of claims**

1. Claims 1-16 are pending.

Claims 1-16 are rejected.

### **Information Disclosure Statement**

2. The information disclosure statement (IDS) submitted on 4/29/2005, 8/20/2004, 3/17/2004, and 3/10/2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

The information disclosure statement filed on 5/02/2005, 3/19/2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### **Claim Rejections - 35 USC 101**

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-16 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, the claims are not directed towards the final result that is "useful, tangible and concrete.

(See State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

According to the New Guidelines of October 26, 2005, which states that “A claim limited to a machine or manufacture, which has a practical application, is statutory. In most cases a claim to a specific machine or manufacture will have a practical application. See Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557)... a specific machine to produce a useful, concrete, and tangible result and State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

(Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility <[http://rs6.net/tn.jsp?t=mdmd7pbab.0.kbg76pbab.p9qiiibab.7440&p=http%3A%2F%2Fwww.uspto.gov%2Fweb%2Foffices%2Fpac%2Fdapp%2Fopla%2Fpreognotice%2Fguidelines101\\_20051026.pdf](http://rs6.net/tn.jsp?t=mdmd7pbab.0.kbg76pbab.p9qiiibab.7440&p=http%3A%2F%2Fwww.uspto.gov%2Fweb%2Foffices%2Fpac%2Fdapp%2Fopla%2Fpreognotice%2Fguidelines101_20051026.pdf)> )

Examiner requests Applicant to include in Applicant's claimed limitations (in all the claims) the following:

What is the practical application?

What is the result?

What is final result that is concrete, useful and tangible?

Because the “practical application, result, concrete, useful and tangible” limitations are not claimed in Applicant’s claims 1, 10 and 14, Examiner believes that the above listed claims are nonstatutory, the claims recite adding the first and second data set and storing them in RF transaction device without recite any thing about the result, useful and tangible.

### **Double Patenting**

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

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*Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No.

10/708585 and claims 12-35 of copending Application No. 10/709,815. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations in this application and those copending Applications are the same.

The following are the matching claims.

10708550	10/708585	10/709,815
1, 10 and 14	1, 15 and 22	12, 26, and 33

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, line 2, the phrase “ the RF transaction device comprising a database” and line 6, 10, the phrase “transaction device database” render claim indefinite because it is not clear that the transaction device database is database of the RF transaction device or not.

With respect to claim 10, line 3, the phrase “ the transaction device including, a data storage area, etc. ” and line 19, the phrase “transaction device” render claim indefinite because it is not clear that the first and second transaction device storage areas are database of the RF transaction device or not.

With respect to claim 14, line 1, the phrase “ the transaction device” and line 12, the phrase “RF transaction device” render claim indefinite because it is not clear how can the interaction device configured to communicate with RF transaction device and the interaction device configured to receive said first and second data to provide said first and second data to said transaction device but before, the first and second data are associated with a transaction device as claim 14 recite in line 2.

Regarding claim 2, the phrase “issuance of the RF transaction device by an issuer” renders claim indefinite because it is not clear who is the issuer, are they the first owner or second owner, how is the issuance of the RF transaction device.

Regarding claim 9, the phrase “the involvement of an issuer of the RF transaction device” renders claim indefinite because it is not clear who is the issuer.

Regarding claim 14, the phrase “without involvement of an issuer of the RF transaction device” renders claim indefinite because it is not clear who is the issuer, are they the first owner

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or second owner.

Regarding claims 2-9, 11-13 and 15-16 depend to claims 1, 10 and 14 so claims 2-9, 11-13 and 15-16 are rendered indefinite.

### **Claim Objections**

5. Claim 4 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim 4. See MPEP § 608.01(n). Accordingly, the claim 4 should refer to other claim.

### **Claim Rejections - 35 USC § 102**

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, and 7-15 are rejected under 35 U. S. C. § 102 (e) as being anticipated by Frieden et al. (U.S. patent No. 6,480,100).

Regarding to the claims 1, and 10, with best understood, Frieden et al. discloses a method and a system for facilitating the adding sets onto a RF transaction device (RFID tag), the device comprising a database configured to store said plurality of data sets distinct one from the other, the method comprising the steps of: facilitating adding to said transaction device database (RFID tag transponder), by an interaction device (tag interrogator) (see column 5, line 3-15), a first data set of a first format at the RF transaction device (RFID tag data storage), wherein said first data set is owned by a first owner (tag user) (see column 7, line 15-20); facilitating adding to said

transaction device database (RFID tag transponder), by an interaction device (tag interrogator), a second data set of a second format at the RF transaction device (RFID tag), wherein said second data set is owned by a second owner (tag user) (see column 7, line 15-20), wherein said first owner is distinct from said second owner, and said first format is different from said second format (see column 3, line 61-68), and facilitating storing a first data set and a second data set on the RF transaction device (RFID tag), wherein said first data set is stored in accordance with said first format, and said second data set is stored in accordance with said second format (see column 7, line 15-39 or see column 16, line 1-40).

With respect to claim 2, with best understood, Frieden et al. discloses first data set is added before issuance of the RF transaction device by an issuer (see column 6, line 62-68 and column 7, line 1-7)(the RFID tag has preexisting data set for tag user to select the format), and wherein second data set is added after issuance of the RF transaction device (see column 6, line 40-50).

With respect to claims 3-4, and 11-12, Frieden et al. discloses facilitating the adding of a first condition header (header format) to one of said first and second data sets, said header added independent of said first or second format (see column 7, line 67)(the data format and header format) and facilitating the adding of at least one of said first and second data sets onto said transaction device database (RFID tag) in accordance with said condition header (see column 7, line 20-40).

With respect to claim 5, it is inherent that Frieden et al. discloses the adding of a third data set to the RF transaction device; wherein said third data set is stored, at least partially, in at least a portion of the data storage space that was used to store said second data set because in



column 3, line 60-67, Frieden et al. discloses each user using an **assigned portion and location** of the available tag memory and formatting the data contained within their respective portion in a data format different from the other tag users.

With respect to claim 7, Frieden et al. discloses RF transaction device includes a transponder operable to communicate in a contact less environment (see column 5, line 12-15).

With respect to claim 8, Frieden et al. discloses first and second data sets are each stored as a block of binary (see column 5, line 55-60 and column 7, line 22).

With respect to claim 9, with best understood, Frieden et al. discloses adding of said first data set is accomplished without the involvement of issuer of the RF transaction device (RFID tag)(an RFID tag user may select and define a series of data elements/files the user desires to store on the tag and the tag user may store the data format in the a data format file and provide that data format without the involvement of issuer of RFID tag) (see column 3, line 1-35) and independent of any other data set owner (see column 3, line 30-35).

With respect to claim 13, Frieden et al. discloses a first data storage area, wherein said first data storage area is configured to receive data of any format (see column 3, line 29-34).

With respect to claims 14 and 16, with best understood, Frieden et al. discloses a data management system comprising: a transaction device (RFID tag) associated with a first data set of a first format and a second data set of second format, wherein said first data set is owned by a first owner and said second data set is owned by a second owner different from the first (see column 3, line 61-68), and wherein said transaction device (RFID tag) is configured to facilitate at least one of a first data set owner and a user (tag user) of said transaction device (RFID tag) in adding said first data set without involvement of an issuer of said transaction device (an tag user

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may select and define a series of data elements/files the user desires to store on the tag and the tag user may store the data format in the a data format file and provide that data format without the involvement of issuer of RFID tag) (see column 3, line 1-35), and an interaction device (tag interrogator) (see column 5, line 3-15) configured to communicate with said RF transaction device (RFID tag), said interaction device (tag interrogator) configured to receive said first and second data and to provide said first and second data to said transaction device (see column 5, line 3-15 and column 16, line 10-40).

With respect to claim 15, Frieden et al. discloses said first and second data sets are added via at least one of: self-service kiosk, and a personal computer (see column 8, line 2-7).

### **Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung T. Vy whose telephone number is (571) 2721954. The examiner can normally be reached on 8-5.

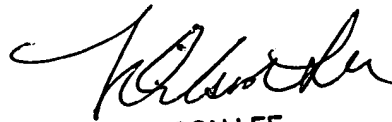
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don K. Wong can be reached on (571)2721934. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hung T. Vy  
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September 1, 2006.



WILSON LEE  
PRIMARY EXAMINER